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EXAMINER

STOREY, WILLIAM C

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,778	<b>Applicant(s)</b> HAYASHI ET AL.	
	<b>Examiner</b> WILLIAM C. STOREY	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 33-34 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Note***

The examiner notes that many problems previously presented and unaddressed by the applicant are re-presented in new claims unresolved. The examiner respectfully requests that the applicant address issues that are previously indicated by the examiner and still relevant even if the applicant wishes to draft new claims. This would greatly serve to cut down on unnecessary redundancy and aid to further the mutually-desired goal of compact prosecution.

### ***Election/Restrictions***

Previously, the printing issue was restricted when presented in claim 13. Though the applicant said that he or she disagreed, no rationale or support was provided to support his or her opinion. If proper support and/or rationale is not provided, claim 34 may be restricted from claim 33.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 34 (and dependents and claims with similarly-contentious limitations) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was

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filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide proper written description support for the claim elements of claim 33 and 34 occurring in the same embodiment. Previously, the printing issue was restricted when presented in claim 13. Though the applicant said that he or she disagreed, no rationale or support was provided to support his or her opinion. If proper support and/or rationale is not provided, claim 34 may be restricted from claim 33. Please provide proper written description support for the claimed elements of claim 34 occurring as claimed. Please consider that claim 34 specifies the action occur when the facsimile-forwarding by the forwarding unit fails. Claim 28, of which claim 34 is dependent, specifies the instructing of the forwarding unit occurring when the presence of facsimile-forwarding is determined, the address of facsimile-forwarding destination is stored in the first memory, and the sender's email address is stored in the second memory. If not all of these conditions are satisfied, the forwarding unit would not be instructed to forward, and thus, would not have the possibility of failing at facsimile-forwarding accordingly. Additionally, please ensure that the limitations of claim 33 and claim 34 both apply in the

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same embodiment and not mutually-exclusive of one another from the same singular understanding of claim 1. For example, make sure that the same an instruction from claim 1 is defined by the same singular reading when interpreting claim 33 and claim 34 so that they are not in a mutually-exclusive state wherein a different interpretation of claim 1 would have to be provided for claim 34 or 33.

2. Claim 30 (and its dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant remarked during the most recent interview that a number of pages as a limit would not correspond to forwarding size upper limit due to the word "size." In addition, the specification presents the forwarding size upper limit as separate from the forwarding page upper limit and provides no other support for the forwarding size upper limit being based on a number of pages.

3. Claim 28 (and dependents and claims with similarly-contentious limitations) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic

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knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide proper written description support for the two distinct memories claimed particular to their claimed limitations.

4. Claim 34 (and dependents and claims with similarly-contentious limitations) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide proper

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written description support for determining plural addresses of a forwarding destination, as claimed in conjunction with the other limitations of claim 34.

5. Claim 34 (and dependents and claims with similarly-contentious limitations) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide proper written description support for printing a report and facsimile-forwarding the report when the facsimile-forwarding fails.

6. Claim 34 (and dependents and claims with similarly-contentious limitations) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was

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filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Please provide proper written description support for "facsimile-forwarding" the printed report to an address of the forwarding destination.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 30 is rejected under 35 U.S.C. 112, second paragraph. The applicant remarked during the most recent interview that a number of pages as a limit would not correspond to forwarding size upper limit due to the word "size." Please explain how the forwarding size upper limit based on number of pages may be acceptable language considering the remarks by the applicant and the disclosure of the specification.

9. Claim 34 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Pg. 1, lines 9-12 describe forwarding contents of a received email through facsimile by converting email data into facsimile data being referred to as fax-forwarding. It does not appear that the printed failure report would be able to



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facsimile-forwarded, then, in conjunction with this understanding and the claimed limitations. i.e. how can a printed report turned into fax forwarding.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufeld et al. (US 5859967), hereinafter referred to as Kaufeld, in view of Eguchi (US 6982803), Miyanaga (US 7009725), and and Okutomi.

Regarding claim 28,

An image communication apparatus, comprising:

an email receiving unit that receives an email (column 3, lines 31-36. The transmission computer reads on claimed email receiving unit and receives email.);

a forwarding unit that facsimile-forwards the email received by the email receiving unit (The transmission computer performs the above and thus, reads on claimed forwarding unit. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37). Fig. 8c shows the attempt of fax transmission (facsimile-forward, in this case) for the process of a converted fax from received email (received in fig. 8a and converted in fig. 8b).);

a setting unit that sets an upper limit for the facsimile-forwarding (column 8, lines 57-59 discloses the use of a transmit counter. Column 9, lines 9-20 disclose that once

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the counter exceeds a predetermined number, which reads on claimed upper limit; the attempts to fax-forward will cease. Fig 8c. The transmission computer performs the processes of fig 8a-8c (column 7, lines 35-37) and thus, reads on claimed setting unit.);

Some may argue that this does not present a size for the upper limit for forwarding. Nonetheless, in a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. The facsimile server is typical for reception of faxes and allows for advance reception of faxes. Sending through a fax server would have been obvious to allow for advance storage, which would save time and allow for greater convenience and management. However, the storage size for holding the fax data is limited (col. 1, 26-31). Considering this issue, Eguchi discloses data size as a forwarding size upper limit of facsimile data (Eguchi discloses a RAM 21, which the capacity of is a designated value, which reads on claimed upper limit based on a data size of data; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size for transmission is larger than the designated value, the facsimile server 2 does not receive the electronic mail from the electronic mail box, hence preventing transmission, as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.)

Kaufeld disclosed being able to compare an instance (counter value, for example) against a limit (predetermined value (col. 9, lines 6-67)). Based on whether

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the limit is exceeded, the fax is allowed to proceed or not. Using this same methodology, a limit could similarly be set based on data size, as taught by Eguchi.

However, Eguchi has taught a receiving side checking the initial size of data to be sent. Though the data may be in email format, the system still shows how the data size is able to be compared for fax storage. However, Eguchi did not distinctly show the sending side checking. Though this would be an obvious connection to have a similar process run by the sending side rather than the receiving side accordingly, the examiner provides a reference that shows the idea of a sending side checking, in order to provide further support.

In a similar field of endeavor, Miyanaga discloses a communication control method and system. Miyanaga discloses at col. 1, lines 63-67, col. 2, lines 1-3 that it is determined whether the transmission data amount of image data to be sent to a server from a communication apparatus exceeds the limit capacity of the server before the image data is sent, and that processing (limiting) is performed when the image data exceeds the limit capacity of the server. Though Miyanaga discloses the scenario with respect to email, the difference with respect to transmission of facsimile data would be insubstantial. In addition, the image data that is checked is the image data from a converted facsimile (col. 3, lines 31-34). The idea of checking reception capacity before transmission could be applied. It would have been obvious to modify the current system by allowing for Kaufeld to check fax server capacity for limiting (Eguchi), but to check before sending (Miyanaga) in order to save a lot of time for the image transmission (col. 1, lines 61-62) that might occur if the data is sent, but not able to be fully received.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaufeld by specifically providing the upper limit being a forwarding size limit of facsimile data, as taught by Eguchi and Miyanaga, for the purpose of saving time.

a first memory that stores a list of addresses of facsimile-forwarding destination to which the facsimile-forwarding is permitted (column 10, lines 54-60 disclose that a user may register destination address(es) that may be registered as a name or name list. From the disclosure, it would have been at least obvious to one of ordinary skill in the art to provide that the sender may refer in the email to registered name for sending for the purpose of allowing for greater flexibility (as opposed to only for a name list) and/or control. The system would be capable of having the name be the receiver whose facsimile data is received. The disclosure discussed the names/name lists register corresponding facsimile numbers. The registered group/list inherently must have be registered in a memory. Such memory may read on claimed first memory.);

a second memory that stores email addresses for which the facsimile-forwarding is permitted (column 4, lines 58-65 disclose registering a user's email address and column 3, lines 36-38 disclose checking to see if there is a valid email address. Column 7, lines 43-51 disclose checking for a valid email address and stopping the flow for forwarding transmission if the sender's address is not valid. A computer corresponds with a registering unit. (figure 3, column 3, lines 44-46) Inherently, since the email addresses are "registered," there must be a second memory for storing/registering the email address(es).);

an obtaining unit that determines presence or absence of a facsimile- forwarding instruction (column 6, lines 45-48 disclose addressing the email to the destination number of the facsimile machine to which the message is to be delivered. column 3, lines 35-42 disclosed the transmission computer sending the email to a facsimile machine. column 7, lines 13-18 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. Figures 4 & 6 disclose the fax number from the email used for the received fax sending. Transmission computer does the converting and analyzing, thus reading on the obtaining unit in the process in order to glean the fax number and determine a facsimile-forwarding instruction. From the previous discussions about the name list, when a name is entered and corresponds with a name/name list for facsimile-forwarding, it may be said that facsimile-forwarding instruction is obtained when the email is analyzed and the name correspondent with the facsimile-forwarding name/name list is found. In such a scenario, similarly as described for the obtaining of the fax number indicating a facsimile-forwarding instruction, the name correspondent to a registered fax number for forwarding would indicate the presence of a facsimile-forwarding instruction.), an address of facsimile-forwarding destination and a sender's email address by analyzing the email received by the email receiving unit (column 3, lines 35-42 discloses the transmission computer checking over the received email, and obtaining a destination of the email and a source of the email (column 3, lines 38-42, col. 6, lines 45-48, col. 7, lines 37-44, column 7, lines 13-18, col. 7, lines 55-57 at least inherently disclose "obtaining" the destination and source at least in order to verify the

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sender and/or to convert and forward the email/facsimile according to the intended destination. Similarly, in the case of the name list, the facsimile number that the email is to be forwarded to may be obtained.);

an instructing unit that instructs the forwarding unit to facsimile-forward the email when the presence of facsimile-forwarding instruction is determined by the obtaining unit, the address of facsimile-forwarding destination is stored in the first memory, and the sender's email address is stored in the second memory (column 7, lines 13-18, column 3, lines 38-42 disclose that the email is converted to a facsimile from the email and the facsimile is automatically generated and originated from information in the email. When a name is used from the name list, it is disclosed that similarly, the email is sent indicating that the name(s) are to receive "the facsimile." In order to help alleviate any possible misunderstandings, it may be mentioned that, additionally, it would have been at least obvious to one of ordinary skill in the art to follow the pattern of fax-forwarding the email with the name destination as the facsimile in order to allow for the benefit of the name list idea to be applied to fax-forwarding method of the overall invention. Fig. 8a-8b show that in order for the email to be converted to fax, the email sender must have a valid account (source match up to sender's email address stored in the second memory). Transmission computer reads on claimed instructing unit. Facsimile data in the conventional manner is sent as image data. Col.8, lines 52-54 discloses the conversion of email into facsimile image data for transmission. It has already been discussed how the conversion occurs when the sender and source match up. The case where additionally the destination of the email matches a name registered

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(stored in the first memory) would be satisfied by the previous limitation being satisfied (having the name/destination match would not preclude conversion). Additionally, in order to forward the facsimile, if the name destination is not registered, the system would not know where to fax the email to, and would thus, not be able to facsimile-forward the document. It has also been discussed how when a name is obtained that corresponds to a registered name for facsimile-forwarding, it may be said that there is a presence of a facsimile-forwarding instruction from the email. Thus, that criterion would be satisfied in the scenario, as well. The facsimile-forwarding may not be instructed from a facsimile-forwarding instruction if it is not present. The email without a fax destination would not be able to fax-forwarded in the particular scenario.);

and a limiting unit that limits the facsimile-forwarding by the forwarding unit when data to be facsimile-forwarded by the forwarding unit exceeds the forwarding size upper limit set by the setting unit (forwarding size upper limit), as previously mentioned with regard to the last claim, in order to prevent errors and free up the system resources (such as transmission availability) for other processes or transmissions that may be completed. Transmission computer may read on claimed limiting unit.)

For further support, Okutomi discloses a saved correspondence table that may correspond email addresses (may be names/receivers as stored in the correspondence table) to facsimile numbers. Fig. 6, col. 2, lines 25-26, col. 3, lines 18-57 discloses how facsimile data may be converted to email and transmitted by corresponding the facsimile destination to the destination email address. The abstract specifies that the

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converting may work in the reverse (vice versa) by converting email to facsimile in a similar fashion.

Therefore, it would have been at least obvious to one of ordinary skill in the art at the time the invention was made to provide having a receiver registered whose facsimile data is received and a facsimile-forwarding destination corresponding to the receiver, determining whether the address of facsimile-forwarding destination is stored, forwarding to the facsimile-forwarding destination corresponding to the receiver registered by the registering unit, as taught by Okutomi, for the purpose of allowing greater convenience and/or control.

Regarding claim 29, the claim is rejected based upon similar reasoning as applied above for claim 28.

Regarding claim 30, the claim inherits everything as applied above for claim 28. However, the previous disclosures fail to disclose limiting by number of pages. However, the examiner maintains that it was well known in the art to provide limiting by number of pages, as taught by Okutomi.

In a similar field of endeavor, Okutomi discloses an electronic mail converting apparatus for facsimile. In addition, Okutomi discloses a LAN controlling section that compares the number of fax sheets to be produced from an email with the maximum output number of sheets, as disclosed at column 6, lines 48-51 and 61-66. The maximum number of sheets the fax machine has to output reads on forwarding size upper limit based on a number of pages. The number of pages that would be transmitted corresponds to image data and thus, data size. If the maximum output



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number of sheets is less than the number of email pages, then the transmission is limited, as disclosed in column 6, lines 66-67 and column 7, lines 1-4 and 14-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing limiting by number of pages, as taught by Okutomi, for the purpose of saving cost, as disclosed in column 7, lines 21-23.

Regarding claim 31, this claim inherits everything as applied above from claim 28. However, the previous disclosures did not distinctly disclose a splitting unit that splits facsimile data into a plurality of the facsimile data; and a split forwarding unit that forwards the plurality of the facsimile data split by the splitting unit to the facsimile destination one after another.

Miyanaga discloses that when the transmission data amount exceeds the capacity (forwarding size upper limit), that the image data to be sent is divided (split) and each divided part is sent one by one so that the amount of data for a single transmission is reduced (col. 9, lines 32-38).

In addition, limiting taught by Eguchi, who taught limiting by capacity, allows for division of fax data, in order to allow for the whole fax to be sent while still working within the confines of the capacity limit (Eguchi, col. 5, lines 50-55).

The splitting and forwarding may be done when a limit is exceeded, like a capacity limit (forwarding size upper limit), so that a disconnection or some other error might be able to be avoided and better success afforded.

Regarding claim 33, the claim inherits everything as applied above for claim 28. Kaufeld discloses a return-mailing unit that return-emails a failure of the facsimile-forwarding to the sender's email address when the facsimile-forwarding by the forwarding unit fails (column 9, lines 9-20 disclose sending an email back to the sender reporting that the facsimile transmission was unsuccessful and details as to why. Fig. 4, column 7, lines 43-44 disclose that the figs. 8a-8c, in which the previous disclosure is contained, are run through for an example of figure 4. Transmission computer reads on claimed return-mailing unit.),

However, the previous disclosures fail to disclose a discarding unit that discards an email for which a failure of the facsimile-forwarding is return-mailed among emails received the email receiving unit. However, the examiner maintains that it was well known in the art to provide discarding the email when there is a transmission failure, as taught by Eguchi.

In a similar field of endeavor, Eguchi discloses a facsimile server, electronic mail device, and communication method. In addition, Eguchi discloses deleting the forwarding data when there is a transmission failure (Eguchi discloses a size limit for forwarding of an email. If the email size is too big, the user may select not to receive the item, to return a message to the sender, or forward it to a destination. If the setting is on return or forward, the memory where the message is received is cleared and the email is deleted from the electronic mail box (column 5, lines 11-41, 18-22, 32-34, & 39-40). Inherently, there must be a discarding unit in order to perform the operation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing a discarding unit that discards an email for which a failure of the facsimile-forwarding is return-mailed among emails received the email receiving unit, as taught by Eguchi, for the purpose of freeing up space in order to allow more messages to come in that might be able to be transmitted.

12. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 28, and further in view of Misawa et al. (US 6771382), hereinafter referred to as Misawa; and Matsumoto et al. (US 6373598), hereinafter referred to as Matsumoto.

Regarding claim 32, this claim inherits everything as applied above from claim 28. It has previously been discussed how the size of a fax to be transmitted may be compared against a reference value (such as the amount of available storage for Eguchi.) However as has not been previously discussed, Misawa points out that communications over a network (such as to send a fax to a relay device 34 in Kaufeld) are subject to limitations in that the amount of information (information capacity) to be processed in a unit time is limited to a certain value (col. 1, lines 50-53). Misawa goes on to explain at col. 4, lines 59-67 that certain times of day correspond to different information capacity limitations. Thus, as size comparison to a reference has been taught, and as Kaufeld has taught waiting a predetermined period of time to resend (col.

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9, lines 4-9), it would have been obvious to consider the information capacity limitation against the data size, and if the data size exceeded the information capacity (forwarding size upper limit), to resend at a later time when the information capacity might increase. This provides for greater system flexibility, robustness, and success. In addition, Kaufeld disclosed that if an attempt to send fails and that the transmit counter has not exceeded the predetermined value, the system waits a predetermined period of time in order to attempt to send the fax again (column 9, lines 4-9). However, as the time limit acts a remedy to initial failures to send, it would have been obvious to one of ordinary skill in the art at the time the invention was made to wait the predetermined period of time for the purpose of using the wait time as the solution to the size limit being exceeded, and allow a chance for a greater capacity to be available in order to see if delaying the transmission will solve the problem. This provides for greater system simplicity. Further, though Kaufeld discloses that the predetermined amount of time could be 5 to 10 minutes, it would of course be obvious to set to a different amount of time for the purpose of providing greater system flexibility. However, Matsumoto discloses being able to schedule facsimile transmission at a specific time or after a certain period of time has passed (col. 1, lines 23-27, col. 1, lines 48-53). Thus, the time may be programmed so that a different delay that would correspond with a time of higher information capacity may be set. This would provide for greater system flexibility, robustness, convenience, and success. The transmission computer of Kaufeld/fax machine mentioned by Matsumoto may read on claimed specifying unit and time-specified forwarding control unit. If the facsimile data is not forwarded until a specific

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time when the limit has been exceeded; inherently, the facsimile-forwarding has been suspended until the time specified (preset time, for example). Data amount of facsimile data is covered by the scope of the discussion.

13. Claim 34 rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 28 above, and further in view of Sekiguchi (US 20020054335) and Ray (US 2004/0128207).

Regarding claim 34, the claim inherits everything as applied above for claim 28. The previous disclosures may not have distinctly disclosed a reporting unit that, when the facsimile-forwarding by the forwarding unit fails, determines addresses of a forwarding destination of the facsimile forwarding and prints a report indicating the failure of the facsimile-forwarding, and facsimile-forwards the report to an address of the forwarding destination. However, Kaufeld discloses a reporting unit that sends a report of facsimile-forwarding failure by an email to a sender of the email when the facsimile-forwarding of the facsimile-forwarding data was stopped by the forward stopping control unit (Column 9, lines 9-20, fig. 8c, disclose that once no further attempts at fax transmission are to be made, an email is sent back to the sender indicating that the facsimile transmission was not successfully transmitted. In addition, details as to why are included. All of this reads on claimed report of facsimile-forwarding failure. Transmission computer reads on claimed reporting unit for reasons disclosed above.)

In a similar field of endeavor, Sekiguchi discloses a communication apparatus. Sekiguchi discloses how it was well known to print a report of transmission failure (retransmission error report, ¶140), rather than email it, as taught by Kaufeld. It would

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have been obvious to one of ordinary skill at the time the invention was made to provide a reporting unit that prints a report of report of facsimile-forwarding failure when the facsimile-forwarding of the facsimile data was stopped by the forward stopping control unit for the purpose of providing a hard copy for records (provides benefit at least in not having to worry about data corruption, lost transmission, etc.).

Additionally, the examiner maintains that it was well known in the art to provide sending a report of a failure of transmission to a destination, as taught by Ray.

In a similar field of endeavor, Ray discloses systems and methods for providing item delivery notification. In addition, Ray discloses a system for notifying recipients and/or senders about the transmission process of a package, for example. Ray discloses sending a notification reporting that an item was not deliverable (as in the package was too big for the mailbox) and that it is being saved for the recipient available to be picked up at a central location, like a post office (§ 36, § 38). In addition, Ray discloses communication with the recipient over a communications system, like the internet (§ 23, 24). The communication to notify the recipient may take place by email or by facsimile, for example (§ 24), by a facsimile to a facsimile destination.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing sending a report of a failure of transmission to a destination, as taught by Ray, for the purpose of allowing a recipient to the know the transmission status of their facsimile delivery and providing more overall system (including the receiver, in this case) awareness.

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In the case that a correspondence table/name from a name list is used, it would be obvious to one of ordinary skill in the art to send a fax to the fax destination(s) (determined address(es)) specified by the corresponding name(s) in a name/correspondence list. The sender who sent an email for fax-forwarding to a name list would not want all of the error messages for the particular names from the name list that had errors to come back to him/her. It would be easier to have the individuals take care of their own facsimile information if they would like it, rather than one individual for all.

### ***Response to Arguments***

14. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/William C Storey/  
Examiner, Art Unit 2625

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